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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/730,299

12/05/2000

Kenneth H. Falchuk

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EXAMINER

PASS, NATALIE

ART UNIT

PAPER NUMBER

3626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/18/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/730,299

Applicant(s)

FALCHUK ET AL.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6 November 2006 has been entered.
2. This communication is in response to the Request for Continued Examination and amendment filed 6 November 2006. Claims 1, 3, and 4 have been amended. Claims 1-4 remain pending.

Claim Rejections - 35 USC §101

3. Claims 1-2 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Under the statute, the claimed invention must fall into one of the four recognized statutory classes of invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter.

(A) Under the guidance of recent case law, the requirements of 35 U.S.C. § 101 are met when “the practical application of the abstract idea produces a useful, concrete, and tangible result” (State Street Bank & Trust Co. vs. Signature Financial Group, Inc., 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998)).

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As per Applicant's recited invention, in general a method for providing continuing medical education credit is conceptually useful for providing accreditation to a physician. However, in the presently recited claims 1-2, it is respectfully submitted that the method recited fails to yield a useful result, in view of the fact that there may never be a credit resulting after the comment is provided to the medical information specialist in the intermediary, and thus the invention fails to recite the usefulness required to satisfy the requirements of 35 U.S.C. § 101.

As such, although claims 1-2 produce a concrete result that is assured or repeatable, and now meet the tests for concreteness and tangibility, in light of the above it is respectfully submitted that the claimed invention, as recited in claims 1 and 2, although tangible and concrete, is not useful, and thus fails to satisfy the requirements of 35 U.S.C. § 101.

Claim Rejections - 35 USC § 112

4. The rejection of claims 1-4 under 35 U.S.C. 112, second paragraph, for being indefinite is hereby withdrawn due to the amendment filed 6 November 2006.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minnesota Medical Association Report on Telemedicine article, September 1996, URL: <<http://www.mnmed.org/Protected/telemedicine.pdf>>, hereinafter known as Telemedicine, for substantially the same reasons given in the previous Office Action (paper number 05172006) and further in view of Bringing Health Care Online: The Role of Information Technologies, Chapter 5: Telemedicine: Remote Access to Health Services and Information article, September 1995, URLs: <<http://www.wws.princeton.edu/ota/disk1/1995/9507/950707.PDF>> and <<http://www.wws.princeton.edu/ota/disk1/1995/9507/950701.PDF>>, hereinafter known as Remote. Further reasons appear hereinbelow.

(A) Claim 1 has been amended to include the recitation of

- “for a consultation between the first physician” on line 2;
- “the consultation being conducted” on line 3;
- “in the intermediary” on line 8; and
- “resulting from the consultation represented by the comment” on line 11.

As per newly amended claim 1, Telemedicine teaches a method of providing continuing medical education credit to a first physician for a consultation between the first physician and a second physician via an intermediary, the intermediary being connected by a telecommunications system to both the first and second physicians,

the method comprising the steps performed in the intermediary of:

receiving a comment or information made with regard to the consultation via the telecommunications system from the second physician (Telemedicine; page 1, column 2,

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paragraph 2 to page 2, column 1, paragraph 1, page 3, column 1, paragraph 4, page 4, column 2, paragraph 4, page 14, column 1, paragraphs 3-4, page 18, column 2, paragraph 2, page 19, column 1, paragraphs 2-3, page 22, column 1, paragraph 4 to column 2, paragraph 2); and

providing the comment to a medical information specialist in the intermediary who is neither the first nor the second physician, the medical information specialist providing any continuing medical education credit resulting from the consultation represented by the comment by recording the resulting continuing medical education credit in a database accessible from the intermediary (Telemedicine; page 1, column 2, paragraph 2 to page 2, column 1, paragraph 1, page 3, column 1, paragraph 4, page 4, column 2, paragraph 4, page 14, column 1, paragraphs 3-4, page 19, column 1, paragraphs 2-3, page 22, column 1, paragraph 4 to column 2, paragraph 2).

Although Telemedicine teaches receiving a comment or information made with regard to the consultation via the telecommunications system from the second physician (as cited above), Telemedicine fails to explicitly disclose

the consultation being conducted through an intermediary, and
receiving a comment or information in the intermediary.

However, the above features are well-known in the art, as evidenced by Remote.

In particular, Remote teaches

the consultation being conducted through an intermediary (Remote; page 168, column 1, paragraph 2); (Examiner interprets the "MCG" (Medical College of Georgia) to be a form of "an intermediary"), and

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receiving a comment or information made with regard to the consultation via the telecommunications system from the second physician in the intermediary (Remote; page 164, column 1, paragraph 1, page 168, column 1, paragraph 2, page 170, paragraph bridging columns 1-2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Telemedicine to include these limitations, as taught by Remote, with the motivations of “reducing the costs of delivering health care” by providing “administrative coordination” and an “electronic clearinghouse of information concerning telemedicine” (Remote; page 160, column 1, paragraph 3, page 170, paragraph bridging columns 1-2, page 191, column 1, paragraph 1).

(B) As per claim 2, Telemedicine and Remote teach a method as analyzed and discussed in claim 1 above

wherein the method further comprises the steps of:

retrieving instructional material or information relevant to the comment and the consultation from the data base (Telemedicine; page 3, column 1, paragraph 4 to column 2, paragraph 1, page 8, column 2, paragraph 1, page 9, column 1, paragraph 3, page 14, column 1, paragraphs 2 to column 2, paragraph 1, page 15, column 1, paragraph 4 to column 2, paragraph 1, page 19, column 1, paragraph 2 to column 2, paragraph 2, page 22, column 1, paragraph 4 to column 2, paragraph 2); and

providing the instructional material to the first physician via the telecommunications system (Telemedicine; page 3, column 1, paragraph 4 to column 2, paragraph 1, page 8, column

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2, paragraph 1, page 9, column 1, paragraph 3, page 14, column 1, paragraphs 2 to column 2, paragraph 1, page 15, column 1, paragraph 4 to column 2, paragraph 1, page 19, column 1, paragraph 2 to column 2, paragraph 2, page 22, column 1, paragraph 4 to column 2, paragraph 2),

the step of retrieving instructional material being performed by the medical information specialist (Telemedicine; page 3, column 1, paragraph 4 to column 2, paragraph 1, page 8, column 2, paragraph 1, page 9, column 1, paragraph 3, page 14, column 1, paragraphs 2 to column 2, paragraph 1, page 15, column 1, paragraph 4 to column 2, paragraph 1, page 19, column 1, paragraph 2 to column 2, paragraph 2, page 22, column 1, paragraph 4 to column 2, paragraph 2).

7. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minnesota Medical Association Report on Telemedicine article, September 1996, URL: <<http://www.mnmed.org/Protected/telemedicine.pdf>>, hereinafter known as Telemedicine, and Bringing Health Care Online: The Role of Information Technologies, Chapter 5: Telemedicine: Remote Access to Health Services and Information article, September 1995, URLs: <<http://www.wws.princeton.edu/ota/disk1/1995/9507/950707.PDF>> and <<http://www.wws.princeton.edu/ota/disk1/1995/9507/950701.PDF>>, hereinafter known as Remote, as applied to claims 1 and 2 above and further in view of Abrahamson et al, U.S. Patent Number 5, 002, 491 for substantially the same reasons given in the previous Office Action (paper number 05172006). Further reasons appear hereinbelow.

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(A) Claims 3-4 have been amended to include the recitation of

- “the continuing medical education credit resulting from the consultation” on lines 8, respectively.

As per newly amended claims 3-4, Telemedicine and Remote teach a method as analyzed and discussed in claims 1 and 2 above wherein the method further comprises the steps of:

the continuing medical education credit resulting from the consultation if the first physician passes the examination (Telemedicine; page 9, column 2, paragraphs 1-2, page 11, column 2, paragraph 4, page 19, column 1, paragraph 2 to column 2, paragraph 1).

Telemedicine and Remote fail to explicitly disclose providing an examination based on at least the instructional material or the comment to the first physician via the telecommunications system;

receiving answers for the examination from the first physician via the telecommunications system;

grading the received answers.

However, the above features are well-known in the art, as evidenced by Abrahamson.

In particular, Abrahamson teaches

providing an examination based on at least the instructional material or the comment to the first physician or student via the telecommunications system (Abrahamson; column 3, lines 25-29, column 4, line 26 to column 5, line 41, column 9, line 51 to column 10, line 41, column 11, lines 17-24, column 17, lines 37-45);

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receiving answers for the examination from the first physician or student via the telecommunications system (Abrahamson; column 3, lines 25-29, column 4, line 26 to column 5, line 41, column 9, line 51 to column 10, line 41, column 11, lines 17-24, column 17, lines 37-45); and

grading the received answers (Abrahamson; column 3, lines 25-29, column 4, line 26 to column 5, line 41, column 9, line 51 to column 10, line 41, column 11, lines 17-24, column 17, lines 37-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Telemedicine to include these limitations, as taught by Abrahamson, with the motivations of providing facilities for automating the giving and grading of examinations, and for completing other routine paperwork associated with monitoring student progress and recordkeeping (Abrahamson; column 3, lines 24-29).

Response to Arguments

8. Applicant's arguments on pages 4-7 of the response filed November 6, 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed November 6, 2006.

(A) Applicant arguments at pages 4-7 of the November 6, 2006 response regarding the rejections of claims 1 and 2 are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied articles teach the environment of providing online education and accreditation.

Galewitz, P. DOCTORS CAN NOW GET CONTINUING EDUCATION ON-LINE,
Palm Beach Post. West Palm Beach, Fla.: Jul 8, 1996. pg. 13.

Tangalos, E. Enabling Technologies for Telepresence, Mayo Clinic/Mayo Foundation,
1996 IEEE, Proceedings of National Forum '95.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the communication
and do NOT sign the communication.

After Final communications should be labeled "Box AF."

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

December 8, 2006

Robert Morgan
Patent Examiner
Art Unit 3626